

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent and Patent Application of:
Vincenzo SCARLATO et al.

Patent No.: 6,914,131

Art Unit: 1631

Issued: July 5, 2005

Examiner: Shubo ZHOU

Patent Ser. No.: 10/864,684 (continuation of above)

Art Unit: 1645

Filed : June 8, 2004

Examiner: P. Baskar

For: NEISSERIAL ANTIGENS

**VERIFIED STATEMENT IN SUPPORT OF PETITION FOR RETROACTIVE FOREIGN
FILING LICENSE PURSUANT TO 37 C.F.R. §5.25**

I, Otis B. LITTLEFIELD, declare as follows:

1. I am submitting this statement in support of the Petition for Retroactive Foreign Filing License for:

- GB App. No. 9723516.2, filed Nov. 6, 1997;
- GB App. No. 9724190.5, filed Nov. 14, 1997;
- GB App. No. 9724386.9, filed Nov. 18, 1997;
- GB App. No. 9725158.1, filed Nov. 27, 1997;
- GB App. No. 9726147.3, filed Dec. 10, 1997;
- GB App. No. 9800759.4, filed Jan. 14, 1998;
- GB App. No. 9819016.8, filed Sept. 1, 1998; and
- PCT App. No. PCT/IB98/001665, filed Oct. 9, 1998 (collectively, the “**GB Priority and PCT Applications**”).

In addition, to the extent that the foreign filing license granted for the subject matter of U.S. Ser. No. 09/303,518 granted June 9, 1999 is ineffective for the following later filed foreign patent applications and patents, this statement additionally in support of the Petition for Retroactive Foreign Filing License for:

- BR App. No. PI9813930-4, filed May 4, 2000;
- CA App. No. 2308606, filed May 4, 2000;
- CN Pat. No. CN1263854, filed June 30, 2000;
- EP App. No. 98946675.0 (issued as EP1029052), filed April 28, 2000 (together with national patents issuing therefrom);
- HK App. No. 00105869.7, filed Sept. 19, 2000;
- JP App. No. 2000-520572, filed May 2, 2000;
- MX App. No. PA/a/00/004363, filed May 4, 2000;
- RU App. No. 2000114245 (issued as RU Pat. No. RU223291), filed June 5, 2000; and
- SG App. No. SG72388, filed April 18, 2000 (collectively, the “**National Phase Foreign Patent Applications**”).
- BR Div. No. PI9816251-9, filed July 31, 2007;
- CN Div. No. 200510113395.7, filed Oct. 17, 2005;
- EP Div. No. 07075379.3 (published as EP1900818), filed May 21, 2007;
- CA Div. No. 2,671,261, filed May 14, 2009;
- HK App. No. 01103903.9 (issued as HK Pat. No. 1033337), filed June 6, 2001;
- JP Div. No. 2005-290551, filed Oct. 3, 2005;
- MX Div. No. MX/a/2009/000817, filed Jan. 21, 2009; and
- RU Div. No. 2004100847, filed Jan. 8, 2004 (collectively, the “**Foreign Divisional Patent Applications**”)

2. I was not aware that a foreign filing license was not obtained prior to the filing of the GB Priority and PCT Applications as I only became involved in the prosecution of the above referenced U.S. patent and patent application as of 2005. I first became aware around October 2007 that work

that was included in the GB Priority and PCT Applications and the above referenced U.S. patent and patent application was performed in Emeryville, CA, through discussions with the inventors of U.S. Ser. No. 11/212,443, regarding the invention of pending claimed subject matter. At that time, I was unaware that the work in the U.S. was unknown to the patent attorneys preparing and filing the GB Priority and PCT Applications and, therefore, that a foreign filing license had not been obtained prior to filing the GB Priority and PCT Applications.

3. I first became aware of the need for a foreign filing license on May 6, 2009, immediately after interviewing Vega Masignani regarding work performed by Vega relating to U.S. Ser. No. 11/212,443 with UK Patent Attorney Cameron Marshall. During the interview, Vega Masignani's work performed in Emeryville, CA, was discussed. Cameron Marshall informed me that a foreign filing license had not been obtained prior to filing the GB Priority and PCT Applications. After learning of the need for a foreign filing license, the procedures for obtaining a retroactive foreign filing license were determined in May 2009. In June and July of 2009, I diligently proceeded to obtain information regarding the foreign filed applications including when each application was filed, who was involved in the filing, and the circumstances regarding the knowledge of the individuals at the time of each filing. Starting in July 2009, I prepared the petition for retroactive filing licenses and contacted those most directly involved to work with them in preparing supporting statements. From July 2009 through November 2009, I worked with those most directly involved to confirm the circumstances regarding their knowledge and work on preparing supporting statements for filing of this petition.

4. The subject matter disclosed in the above patent and patent application and in the GB Priority and PCT Applications, the National Phase Foreign Patent Applications and the Foreign Divisional Patent Applications relates to polypeptides and nucleic acids encoding such polypeptides derived from *N. meningitidis* determined to have utility as recombinant vaccine components. To the best of my knowledge, this subject matter was not under a U.S. secrecy order at the time that the GB Priority and PCT Applications or the Other Foreign Patents and Patent Applications were filed and this subject matter is not currently under a U.S. secrecy order. A continuation-in-part US patent application (Ser. No. U.S. Ser. No. 09/303,518) that included all of the subject matter disclosed in

the GB Priority and PCT Applications, the National Phase Foreign Patent Applications and the Foreign Divisional Patent Applications was filed April 30, 1999. The filing receipt for the continuation-in-part patent applications indicates that a foreign filing license was granted June 9, 1999, confirming that the subject matter was and is not under a secrecy order. Given that the subject matter is relating to antigens for vaccination, it would not have been expected to raise any national security concerns.

5. All statements made herein of my personal knowledge are true and all statements made on information and belief are believed to be true.

6. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under § 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the patent and patent application or any patent issued thereon.

10/10/05
Date

OTB
Name: Otis B. LITTLEFIELD